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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,526	09/18/2003	Gary B. Paul	1033-SS00418	5896
60533	7590	11/15/2007	EXAMINER	
TOLER SCHAFFER, LLP			AVELLINO, JOSEPH E	
8500 BLUFFSTONE COVE				
SUITE A201			ART UNIT	PAPER NUMBER
AUSTIN, TX 78759			2143	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/666,526

**Applicant(s)**

PAUL, GARY B.

**Examiner**

Joseph E. Avellino

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-43 are presented for examination; claims 1, 29, and 36 independent.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-43 are rejected under 35 U.S.C. 101 because they do not provide a concrete, tangible, and useful result. The claims essentially generate an email, however nothing is done with this email and therefore this merely amounts to the modification of software or a calculation of a value. As such, since nothing is done with this particular email, this does not satisfy the concrete, tangible, and useful result clause as required by MPEP 2106. It is requested to amend the claim such that an action is done to the email to provide a result (i.e. sending the email back to the sender of the incoming email). Correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 14, 23, 27, 29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (US 20030172133) (hereinafter Smith).

4. Referring to claim 1, Smith discloses a method of processing incoming emails (i.e. electronic request from a user) (e.g. abstract), the method comprising:

receiving an incoming email (Figure 1; p. 1, ¶ 24);

determining whether the email requires a response (i.e. all emails require a response, and therefore the system inherently determines whether the email requires a response) (e.g. abstract);

generating an auto reply email to the incoming email (i.e. auto-response) (Figure 2, ref. 30 and related portions of the disclosure); and

wherein the incoming email is processed to determine characteristics of the auto reply email (i.e. based on the nature of the request determined by examining keywords from the incoming email, generate possible solutions and send them back) (p. 2, ¶ 41).

5. Referring to claim 2, Smith discloses separating the email into a plurality of parts, the parts including control information (i.e. extract the email address of the sender) (Figure 2, ref. 22); and processing the control information to determine characteristics of the email (¶ 37).

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6. Referring to claim 14, Smith discloses generating the auto reply email comprises separating the email into a plurality of parts, the parts including a message body portion, processing the message body portion producing an extracted text portion (i.e. question), choosing an auto reply email template, and forming the auto reply email using the email template and adding the extracted information into the template (p. 2, ¶ 45).

7. Referring to claim 23, Smith discloses determining if the email is one of a reply containing a customer inquiry that requires a response (i.e. if a call has already been created, information is retrieved from the system (Figure 2, ref. 22; p. 2, ¶ 37).

8. Claims 27, 29, and 31 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 24, 25, 30, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

10. Referring to claim 19, Smith discloses the invention substantively as described in claim 14. Smith does not explicitly state that the system is capable of removing attachments from the message, however this feature is well known in networking in order to prevent virus attacks from unknown senders. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for the removal of attachments is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Smith to incorporate the well known features of attachment removal in order to reduce bandwidth over a link, as well as to ensure the security of the network from viruses.

11. Referring to claims 24 and 25, Smith discloses the invention substantively as described in claim 1, however does not specifically disclose receiving a no-reply from address to an email sent to a plurality of customers, however this feature is well known with spammers to determine whether this particular email address is valid. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for determining if a no-reply from address is received is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to combine the teaching of Smith to determine if a reply has come from an address in order to ensure that email lists are up to date for the customer database and to be able to prune addresses accordingly.

12. Claims 30, and 38 are rejected for similar reasons as stated above.

Claims 3, 4, 7, 12, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Carey (US 20030025943).

13. Referring to claim 3, Smith discloses the invention substantively as described in claim 2. Smith does not specifically disclose the control information includes a region identifier and an application identifier to determine a particular template for the reply email, however Smith discloses utilizing control information to determine the particular template (see claims above). In analogous art, Carey discloses extracting tracking identifiers from the reply emails to track the particular transactions (i.e. tracking codes) (p. 3, ¶ 40). It would have been obvious to one of ordinary skill in the art to combine the teaching of Carey with Smith in order to utilize the tracking codes of Carey with the incoming 'calls' of Smith to further track the customer's interactions with the system, resulting in a more efficient solutions to be found with the helpdesk system of Smith.

14. Claims 4, 7, 12, and 35 are rejected for similar reasons as stated above.

Claims 5, 6, 21, 22, 26, 28, 32, 33, 36, 37, and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Carey in view of Matthews et al. (USPN 6,865,268) (hereinafter Matthews).

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15. Referring to claims 5 and 6, Smith-Carey discloses the invention substantively as described in claim 4. Smith-Carey does not specifically disclose that the email template includes a webpage or text message linked to a customer feedback tool. In analogous art, Matthews discloses another method of customer management which sends emails back to people which includes a link to a feedback web form where the customer is capable of providing feedback (any email which includes an internet link can be construed as a web page) (col. 9, lines 44-58). It would have been obvious to one of ordinary skill in the art to combine the teaching of Matthews with Smith and Carey in order to allow the users of Smith the ability to provide feedback on how well the automated response system is able to answer their questions appropriately, thereby providing an avenue for a customer to notify an administrator as to how well the system can appropriately answer a question supplied by a customer.

16. Claims 21, 22, 26, 28, 32, 33, 36, 37, and 39-43 are rejected for similar reasons as stated above.

Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Tomono (US 20030177189).

17. Referring to claim 8, Smith discloses the invention substantively as described in claim 2. Smith does not specifically disclose the control information includes a reply email loop count. In analogous art, Tomono discloses an email handling system which



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discloses tracking the number of replies to a sender email, and if the number of replies is greater than a threshold, then halting the sending of emails (see claims 4 and 8, and Figures 5 and 6). It would have been obvious to one of ordinary skill in the art to combine the teaching of Smith with Tomono in order to reduce automatically generated emails and reducing superfluous email transmissions from auto reply systems.

18. Claims 9-12 are rejected for similar reasons as stated above.

19. Referring to claim 13, Smith-Tomono discloses the invention substantively as described in claim 12. Smith-Tomono do not specifically disclose that the application identifier identifies one of a marketing application, billing application or confirm status application, however numerous identifiers can be added to emails to determine the source and routing information. By this rationale, one of ordinary skill in the art would understand the benefits of using the identifiers to identify a marketing, billing, or status application in order to help identify particular routing in the agent call system of Smith, thereby allowing the system a further identifier to use in order to properly route the email to a proper destination which could fulfill a particular request.

Claims 15-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Dezonno (US 20030172185).

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20. Referring to claims 15-17, Smith discloses the invention substantively as described in claim 14. Smith does not explicitly state that the email comprises HTML, converting the email into text, removing lines, truncating the text, and inserting the text into a web field in the email template. In analogous art, Dezonno discloses another email transmission method which can extract keywords from a sent email, and then insert data into web fields embedded in the templates to generate auto emails (Figure 3; p. 4, ¶ 38-43). Although the use of removing HTML tags is not expressly taught, one of ordinary skill in the art would clearly understand that HTML could be found in the email body, since HTML based emails are prevalent in the art, and systems which extract field codes and truncate data based on field sizes are well known in the art. It would have been obvious to one of ordinary skill in the art to combine the teaching of Dezonno with Smith in order to provide an efficient method for the population of email templates to the system of Smith.

21. Claims 18 and 20 are rejected for similar reasons as stated above.

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'J. Avellino', with a stylized flourish at the end.

Joseph E. Avellino, Examiner  
November 12, 2007